

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Paper No. 9
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Herzog-Elmiger Inc.

Serial No. 75/898,699

Jay S. Horowitz, Esq. for Herzog-Elmiger Inc.

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(Thomas Lamone, Managing Attorney).

Before Simms, Cissel and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Herzog-Elmiger Inc. has filed an application to register the term "VENEERONLINE.COM" as a service mark for "wholesale mail order, catalog order, and on-line order services in the field of wood veneers."¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the term "VENEERONLINE.COM" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

¹ Ser. No. 75/898,699, filed on January 19, 2000, which is based on an allegation of a bona fide intention to use such term in commerce.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys information concerning any significant ingredient, quality, characteristic, feature, function, purpose, subject matter or use of the goods or services. See, e.g., In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used or is intended to be used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of such use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant, in its brief, candidly admits that it "does not dispute that its mark is formed from descriptive terms." Applicant submits, however, that among other things, "its mark as a whole should not be regarded as descriptive" because "the term

VENEERONLINE.COM does not merely describe Applicant's services."² Although the reason for such assertion is not explicitly stated, it appears from applicant's citation to *Q-Tips, Inc. v. Johnson & Johnson*, 206 F.2d 144, 98 USPQ 86, 88 (3rd Cir. 1953) at n. 8, for the proposition that "two or more descriptive terms may be combined to form a valid, arbitrary trademark," that applicant is contending that the combination of the admittedly descriptive terms comprising the term "VENEERONLINE.COM" results in a nondescriptive phrase or designation. However, as stated by the

² Over half of applicant's brief is devoted, however, to what seems to be an argument that the mere descriptiveness refusal is premature because applicant has yet to submit specimens of use of the term it seeks to register as its mark. Applicant's argument appears to be predicated on the Examining Attorney's citation in his final refusal to *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998), a case involving a refusal to register the term "WWW.EILBERG.COM" on the basis of the failure thereof to function as a mark rather than on the ground of mere descriptiveness. Such case was cited in support of the proposition that the "ONLINE.COM" portion of the term which applicant seeks to register is not source-indicative because it "form[s] a commonly used internet address for those who have web sites." However, apparently because the Examining Attorney went on to state that "because the designation appears to form part of an address commonly used by internet users and merely indicates the location on the internet where applicant's web cite could appear, it does not indicate the source of applicant's services," applicant contends that a refusal to register in the absence of its having commenced use is premature.

While applicant would be correct to the extent that a refusal of registration on the ground of failure to function as a mark would be premature absent the submission of specimens of use (and, we further note, would also be premature by virtue of its having been raised for the first time in the final refusal), the sole ground of refusal which is properly before us on appeal is that of mere descriptiveness. As the Examining Attorney, citing *Eastman Kodak Co. v. Bell & Howell Document Management Products Co.*, 994 F.2d 1569, 26 USPQ2d 1912, 1915 (Fed. Cir. 1993) correctly observes in his brief, mere descriptiveness and failure to function as a mark "are different issues." Thus, as the Examining Attorney also properly notes, the refusal on the former ground may be determined in the absence of specimens of use inasmuch as such "refusal is not predicated upon how the mark is used in commerce, as was the situation in *Eilberg*, supra, but [upon] the descriptive aspect of the designation [sought to be registered] itself." The refusal on the basis of mere descriptiveness, therefore, is not premature.

Board in, for example, *In re Medical Disposables Co.*, 25 USPQ2d 1801, 1804 (TTAB 1992), in order for such to be the case:

[T]he mere act of combining does not in itself render the resulting composite a registrable trademark. Rather, it must be shown that in combination the descriptiveness of the individual words [and/or term] has been diminished, [such] that the combination creates a term so incongruous or unusual as to possess no definitive meaning or significance other than that of an identifying mark for the goods [or services]. See *In re Calspan Technology Products, Inc.*, 197 USPQ 647 (TTAB 1977).

We concur with the Examining Attorney that the combination of the admittedly descriptive terms "VENEER" and "ONLINE.COM" to form the term "VENEERONLINE.COM" is merely descriptive of applicant's "wholesale mail order, catalog order, and on-line order services in the field of wood veneers." Combining such terms does not create a composite which is so incongruous or unusual, or which otherwise possesses a new meaning different from its constituent terms, as to possess no definitive meaning or significance other than that of an identifying mark for applicant's services. Instead, as succinctly noted by the Examining Attorney in his brief:

The word "veneer" identifies the goods that are the central characteristic of applicant's services and the designation "online.com" identifies a computer address commonly used on the Internet, which when combined indicates that a potential purchaser could access, by way of the Internet, applicant's services involving wood veneers.

As support for the latter, the Examining Attorney has made of record definitions from the Microsoft Press Computer Dictionary (3d ed. 1997) which in relevant part defines ".com" as

connoting "1. In the Internet's Domain Name System, the top-level domain that identifies addresses operated by commercial organizations. The domain name .com appears as a suffix at the end of the address" and "online" as meaning "3. In reference to a user, currently connected to the Internet, an online service, or a BBS or using a modem to connect to another modem." In addition, the Examining Attorney, by a search of the "NEXIS" online database, has made of record numerous examples, of which the following are representative, of commercial websites which utilize "online.com" as a portion of their domain names:

"Textileparts - online
(www.textileparts- online.com) hopes to use the Internet to electronically link textile machinery suppliers and buyers while addressing supply chain inefficiencies." -- Textile World, November 2000 (article headlined: "NEW FIRM SPECIALIZES IN PARTS");
and

"Lloyd's ... recently introduced an on-line system for buying total loss only (TLO) reinsurance via the internet.

The syndicates say that www. tlo-online.com has been developed to speed the process of obtaining cover in this relatively specialized area of marine reinsurance." -- Reinsurance Magazine, October 9, 2000.

Clearly, in light of the above evidence (and regardless of applicant's admission of the descriptiveness of the component elements thereof), the term "VENEERONLINE.COM" directly conveys significant information about the nature of applicant's services, namely, that they involve, among other things, the online commercial ordering of veneers. Specifically, inasmuch as the language "wood veneers" appears in applicant's recitation of services, there is simply no question that the word "VENEER" in

the term "VENEERONLINE.COM" signifies to customers for such services its ordinary meaning and thus merely describes that one of the central features of applicant's "wholesale mail order, catalog order, and on-line order services in the field of wood veneers" is the sale of such products. Moreover, as to the term "ONLINE.COM," not only is the ".COM" portion thereof lacking in service mark significance because, as a top level domain name, it would be regarded as designating a commercial website by actual and potential customers of applicant's services, but the "ONLINE" portion thereof plainly indicates the online nature of such services and would likewise be so understood. See, e.g., 555-1212.com Inc. v. Communication House International Inc., 157 F. Supp. 2d 1084, 59 USPQ2d 1453, 1457-59 (N.D. Cal. 2001) [term "555-1212.com" is merely descriptive of "providing databases featuring telephone and directory information accessible via electronic communication networks" because, "[m]uch like the telephone number '411' for local calls, '555-1212' is the number one would dial (after an area code) to seek out telephone and directory information services outside of one's local area code" and thus, "[t]o the average consumer, '555-1212.com' would indicate a commercial web site on the Internet which provides similar telephone and directory information"]; and 1 J. McCarthy, McCarthy on Trademarks & Unfair Competition §7:17.1 (4th ed. 2002) at 7-28.1 ["a top level domain ['(TLD)'] indicator [such as '.com'] has no source indicating significance and cannot serve any trademark [or service mark] purpose" and "[t]he same is true of other non-distinctive modifiers used in domain names, such as

'http://www" and "html"; thus, because "the TLD '.com' functions in the world of cyberspace much like the generic indicators 'Inc.,' "Co.,' or 'Ltd.' placed after the name of a company," "[a] top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark]"].

Consequently, when used in connection with applicant's "wholesale mail order, catalog order, and on-line order services in the field of wood veneers," the term "VENEERONLINE.COM" immediately describes, without conjecture or speculation, that the nature, purpose or subject matter of such services includes online commercial ordering of veneers. Plainly, when viewed in the context of applicant's services, persons desiring to find information on the Internet which pertains to ordering of wood veneers will know directly, without the need for the exercise of imagination, cogitation or mental processing or the gathering of further information, that applicant's "VENEERONLINE.COM" services encompass a commercial online website devoted to veneers. Nothing in such term, as noted previously, is ambiguous, incongruous or perhaps susceptible to any other plausible meaning. The term "VENEERONLINE.COM" is accordingly merely descriptive of applicant's services within the meaning of the statute. See, e.g., In re Putnam Publishing Co., 39 USPQ2d 2021, 2022 (TTAB 1996) ["FOOD & BEVERAGE ON-LINE" for "a news and information service updated daily for the food processing industry, contained in a database" held merely descriptive because the term "ON-LINE" describes the mode through which the

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service is rendered and the term "FOOD & BEVERAGE" describes its subject matter; therefore, "the relevant class of consumers will immediately understand, without the need for imagination, thought or perception, that applicant's FOOD & BEVERAGE ON-LINE news and information service provides food and beverage news and information via interactive computer access"].

Decision: The refusal under Section 2(e)(1) is affirmed.